

**THIS OPINION IS NOT CITABLE
A PRECEDENT OF
THE T.T.A.B.**

Mailed 12/16/2004

UNITED STATES DEPARTMENT OF COMMERCE

Trademark Trial and Appeal Board

In re Dunn-Edwards Corporation

Serial No. 76201822

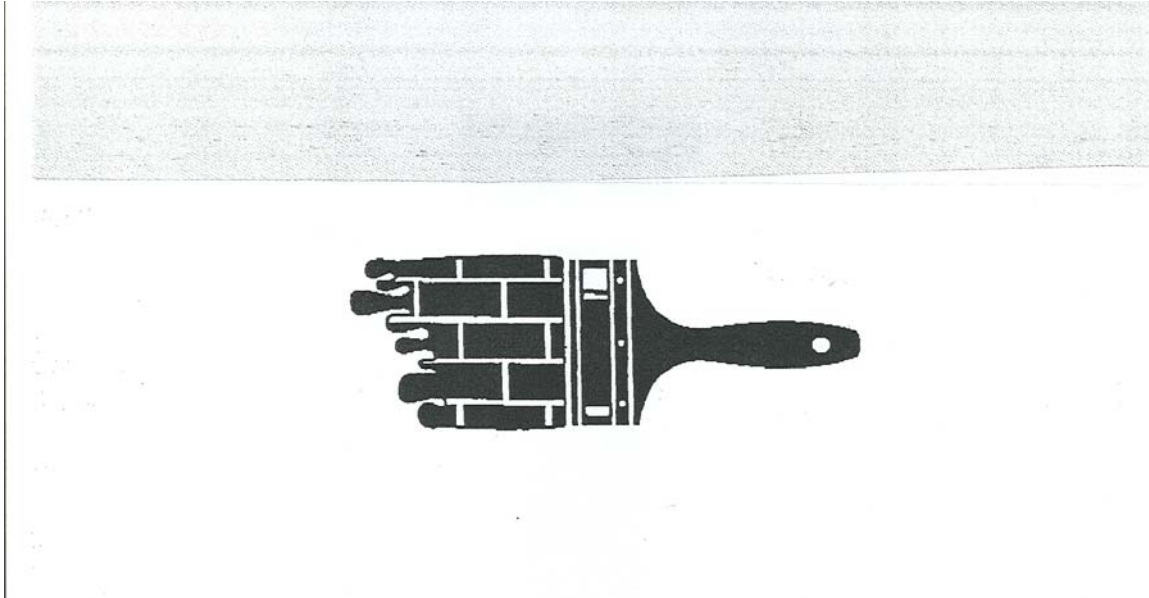
I. Morley Drucker of Fulwider Patton Lee & Utecht for Dunn-Edwards Corporation.

Toni Y. Hickey, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney).

Before Simms, Hanak and Rogers, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

On September 29, 2001 Dunn-Edwards Corporation
(applicant) filed an intent-to-use application seeking to
register the design shown below for "paint for use on
masonry." On September 17, 2002 the Office issued a Notice
of Allowance. Subsequently, on October 29, 2002 applicant
filed its Statement of Use along with a specimen of use,
which is a label affixed to one of applicant's paint cans.



After applicant filed its Statement of Use, the Examining Attorney -- citing Sections 1, 2 and 45 of the Trademark Act -- refused registration on the basis that as used on the specimen, applicant's design does not function as a trademark.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In deciding this case, it is critical to note that "the Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be a registration, there must be a trademark, and unless words have been so used they cannot qualify." In re Bose Corp.,

546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976). Thus, "an important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a trademark with respect to goods named in the application." Bose, 192 USPQ at 216.

As previously noted, applicant's specimen of use is a label affixed to its paint can. As it appears on the specimen of use, the design which applicant seeks to register does not function as a trademark, but rather functions merely as an informational icon, along with other informational icons, to indicate the "Application Use" for a particular can of paint. As used on the specimen, applicant's design appears in a very subordinate fashion (i.e. far less than the size of a postage stamp) and the design merely indicates that the paint can be used on masonry. Eight other very small informational icons appearing on the label indicate that this paint is water-based, but not solvent-based; that this paint is good for both interior and exterior use; that this paint can be used

on dry wall, wood and metal; and that this paint has a certain gloss range.

In addition to submitting a label, applicant also submitted an advertising poster entitled "Our Instructions Are Now in Sign Language." On this poster there appear 14 small informational icons including the design sought to be registered. These 14 designs are repeated three times -- once below a repetition of the words "Our Instructions Are Now in Sign Language" and twice beneath these same words in two other languages. This poster only further emphasizes to consumers of paint that applicant's design is but one of many informational icons that are used to instruct purchasers as to how to use the paint. As used on both the label and the sales poster, consumers would perceive applicant's very small design not as an indication of the origin of the paint (trademark), but rather would instead perceive applicant's design merely as an informational icon indicating that a particular can of applicant's paint is suited for use on masonry.

In addition, we note that during the examination process the Examining Attorney submitted a picture of a can of paint from one of applicant's competitors which also used informational icons, albeit not the identical informational icons used by applicant. The Examining

Attorney notes that the fact that competitors also use informational icons would only further accustom consumers to view applicant's design as but a mere informational icon and not as a trademark.

We note that applicant devotes a substantial portion of its brief (pages 5-9) arguing that its design "is not merely descriptive," but is "either arbitrary, fanciful or suggestive." Applicant's argument is totally misplaced. The issue before this Board is not whether applicant's design is merely descriptive, but rather whether applicant has used this design in the manner of a trademark or rather instead as a mere informational icon. In this regard, it is noted that words and designs "are not registerable merely because they do not happen to be descriptive of the goods or services with which they are associated." In re Standard Oil Co., 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960).

Finally, applicant notes that it has obtained registrations for other of its informational icons including its light bulb design indicating interior use; its sun design indicating exterior use; and its water faucet design indicating that the paint is water-based. Registration Nos. 2,640,709; 2,640,710; and 2,693,949. In each of these three registrations, the description of goods

varies slightly. Thus, for the light bulb design indicating that the paint is suitable for interior use, the description of goods reads "paints formulated for interior use." Likewise, for the sun design indicating that the paints are for exterior use, the description of goods reads "paints formulated for exterior use." Finally, with regard to the water faucet design indicating that the paint is water-based, the description of goods reads "water-based paints for interior and exterior use."

We have two comments with regard to applicant's prior registrations. First we are not privy to the records in those three application files which resulted in those three registrations. In particular, we are not privy to the specimens of use which applicant submitted in order to obtain these registrations.

Second, in any event, this Board is certainly not bound by the actions of Examining Attorneys in allowing marks to be registered. West Florida Seafood v. Jet Restaurants, 31 F.3d 1122, 31 USPQ2d 1660, 1664 (Fed. Cir. 1994).

In sum, because we find that as used on the specimens applicant's design functions merely as an informational icon and not as a trademark, the refusal to register is affirmed. Moreover, we note that our decision is supported

Ser. No. 76201822

by applicant's own advertising poster which further confirms that applicant's design functions as but one of many icons indicating how the paint is to be used.

Decision: The refusal to register is affirmed.